

Also, the feature of claim 21 is alleged to already be recited in claim 10. On the contrary, claim 21 recited that the introducing of claim 10 comprises the activity of *filling* the shaped sugar wafer with certain material. Claim 10 clearly does not recite the active verb "filling" as a process feature. Instead, claim 10 recites only that the substantially water-free fat based *confectionery filling* (a thing, or noun) is introduced (a verb) upon or into the wafer. Since the usage of the different noun and verb forms of the word "filling" in claims 10 and 21 appears to be confusing to the Patent Office, Applicants have amended claim 21 to clarify that the mass is *disposed* into the shaped sugar wafer. Thus, this rejection is respectfully submitted to be improper and has been rendered moot by these amendments, and should be withdrawn for either reason.

Claims 1 and 3-21 were rejected under 35 U.S.C. § 103 (a) as being obvious over U.S. Patent No. 5,709,898 to Biggs et al. ("Biggs") for the "same reason set forth" in paragraph 6 of paper no. 5 and for the additional reason set forth" on page 2 of the Office Action. Applicants respectfully traverse.

The position set forth in paragraph 6 of the previous Office Action is that: (a) it would be obvious to make any shape of wafer desired; (b) in any size desired; and that (c) hardening the filling simply depends on the type of filling and texture desired; and that (d) it would be obvious to include inclusions; and (e) it would be obvious to use any filling depending on the taste desired. The current Office Action adds that: (f) the amount of flour does not define over prior art because it is well known for wafer recipes to vary depending on the size of wafer and taste desired; and that (g) the dome shape would be obvious because Biggs teaches that any shape can be achieved. In short, the position in the Office Action is that any food product including a "sugar wafer" would be obvious in view of Biggs, and that any process of preparing a food product involving a "sugar wafer" would be obvious in view of Biggs. This is *clearly* an improper rejection. Hindsight review of an application is an improper basis for a rejection. Applicants maintain that--while it may be "obvious" to modify one or two aspects of a disclosure to arrive at a claimed invention, it is clearly not obvious to modify *every* feature to allegedly arrive at a teaching of a claimed invention, particularly when no motivation exists in the cited art.

The Office Actions do, however, collectively concede that Biggs does not disclose a cone shape, the food product size, or the feature of allowing the confectionery to harden within the wafer (*See, e.g.*, Office Action mailed October 1, 2001 (Paper No. 5)).

Initially, Applicants would like to make clear for the record that claims 1, 3-9, and 18-20 recite a food product and claims 10-17, 21, and new claim 23 recite a process for

preparing a food product. The Examiner even acknowledged the difference between the two types of claims during the Interview of April 24, 2002, when it was indicated that the amendment clarifying the process claims would probably distinguish over the prior art pending further search. With all due respect, the rejection seems to have overlooked this distinction and earlier discussion.

In reality, Biggs is directed to a process for manufacturing a food product, wherein a food core is pre-formed, then a wafer is heated to become deformable, and then the deformable wafer is shaped around the pre-formed food core. Biggs also discloses that the food core may comprise "any desired ingredients such as ice cream, fish, meat, vegetables, fruit, nuts, chocolate pieces and the like. Preferably, the food core is ice cream" (Col. 1, lines 61-66). Inherently, the food core must be sufficiently solid to have a wafer formed around it. Biggs does not teach the combination of a filling including a mass of a substantially water-free based confectionery material in a sugar wafer cone, as presently recited, to provide a food product that is eaten like ice cream but is not ice cream. Biggs has absolutely no teaching in this regard, and it is directed only to an improved way to form a wafer around a pre-formed food core.

At best, Biggs teaches that a sugar wafer of any of a variety of shapes can be prepared with any of a variety of food products inside of it. Thus, Biggs at best teaches a vast genus of shape/food product combinations, but it fails to teach the specific combination presently recited, as well as other features noted in the discussion herein. The presently recited invention surprisingly and unexpectedly provides a delightful ice cream-like product that is not ice cream. More importantly, Biggs teaches to use ice cream and various other water-containing food products. The present claims specifically limit the use of such water-based filling materials, which can have an adverse effect on the sugar wafer cone. Specifically, claim 1 recites the filling including a mass of a substantially water-free based confectionery material, such that Biggs actually *teaches away* from the present invention by suggesting water-containing fillings are preferred, *i.e.*, ice cream. No *prima facie* case of obviousness has been shown since Biggs fails to teach the specific shape/filling combination, particularly in view of Biggs teaching away from the claimed substantially water-free filling.

Moreover, most of the specific foods listed in Biggs are not even fat-based confectionery products, and none are introduced into the sugar wafer cone from a molten, semi-liquid, or semi-solid mass that solidifies prior to consumption so as to form a product that fits in the claimed cone shape, since Biggs *teaches away* from forming products in this manner by forming the food core first. This difference is not a "mere process step" that is

irrelevant to the product. Indeed, Biggs cannot obtain the claimed structure because it teaches pre-forming the food core and then providing a shaped wafer. Since Biggs does not even suggest forming a cone-shaped filling *first*, and then forming the wafer around such a shape, it cannot obtain the claimed product where the sugar wafer cone acts to mold the shape of the filling mass.

The fact that Biggs teaches a food core that is preferably *ice cream* shows that Biggs is not concerned with a food product that will solidify, such as to avoid melting in hot weather or during prolonged handling as is typical with ice cream products (See Specification, page 2, lines 17-18). Indeed, Biggs is directed primarily to the unique problems of forming sugar wafer cones that are *open*, *i.e.*, do not define an enclosed space. Thus, Biggs does not teach a cone that acts as a handle to keep a user's hands clean during eating of the confectionery product, as presently recited.

¶ The Office Action alleges that Biggs teaches chocolate pieces as a substantially water-free confectionery material. Aside from the lack of a motivation for one of ordinary skill in the art to pick and choose one particular food filling out of the Biggs list and to simply optimize all the other claimed features, this still fails to teach the present invention. On the contrary, the present invention has been amended to more clearly recite that the product has, and the process provides for, adding a confectionery filling in the form of a mass. Pieces of chocolate, by definition, are not a mass. Thus, Applicants continue to maintain that Biggs completely fails to teach the confectionery filling mass previously recited in claim 10 and now also recited in claims 1 and 23. While Biggs also teaches ice-cream, which is typically a mass, it is not substantially water-free, as presently recited. Also, there would have been no reasonable expectation of success for one of ordinary skill in the art in view of Biggs to have arrived at the completely different product and--from Biggs' point of view--backward and different process to arrive at the presently claimed invention. The only similarities between Biggs and the presently recited invention are that they each relate to a sugar wafer and an edible core, however, no demonstration exists anywhere on the written record of how or why one of ordinary skill in the art, even aware of Biggs, would have been motivated to provide the presently claimed invention.

Furthermore, claim 5 recites a more specific combination of substantially water-free confectionery filling with a specific amount of chocolate and from about 10 to 40 percent vegetable fat. Biggs completely fails to suggest this filling, particularly in combination with the other features recited in claim 1. Claim 6 recites an even more specific combination of filling materials of chocolate and non-lauric vegetable fat. These features are

clearly not taught by Biggs, and would likely result in a filling that--while solidified after provided into the wafer--would be too soft to form a wafer around as per Biggs' process. New claim 20 recites 20 to 60 weight percent of flour in the sugar wafer cone, in combination with the features of the filling recited in claim 5 and the other distinct features of claim 1. Biggs teaches only 67 weight percent flour in its wafer. The wafer composition can be important to avoiding fat migration from the filling into the wafer (*See, e.g.*, Specification at page 4, lines 16-32). Claim 20 also recites that a top portion of the filling is domed to provide the food product with an ice cream-like appearance. Biggs fails to teach such a structure, particularly in combination with the other features recited in independent claim 1. Dependent claim 22 recites that the confectionery filling is solid under ambient temperature, as compared to ice cream, which would melt under such conditions. Thus, claims 5-6, 20, and 22 are even more clearly distinct from Biggs.

With respect to process claims 10-17 and new claim 21, Biggs teaches a completely different process. In particular, claims 10, 11, and 21 and several claims depending therefrom recite processes of making a sugar confectionery product by providing the sugar wafer in a desired shape and *then* adding the confectionery filling into the shaped wafer. Claim 23 has been added to clarify this surprising and unexpected feature of the present invention compared to Biggs. Even if the resultant product of these processes were identical to the Biggs product, which it is not, these different and reversed processing steps would not and could not render the process claims obvious in view of Biggs. Indeed, Biggs discloses pre-forming a food core, then heating at least a portion of a wafer, and in the end, shaping the wafer around the food. Claims 10-11 of the present invention, however, recite a completely opposite process--providing the sugar wafer in a desired shape, and then introducing a substantially water-free fat-based confectionery in a molten, semi-liquid, or semi-solid mass upon or into the shaped sugar wafer, and then allowing the confectionery to harden. Claim 11 in part further recites that the wafer is formed into a cone shape. Biggs clearly fails to teach a process of forming a wafer in a desired shape and *then* providing the molten filling. In fact, Biggs *teaches directly away* from this process by requiring pre-forming of the food core and *then* shaping the wafer around the hard food core.

The Examiner suggested at the interview that the claim term "introducing" was not sufficient to distinguish over Biggs, but this is irrelevant since Biggs teaches away from the order of preparation presently claimed. Indeed, Biggs' patentability is in large part based on the processing since the presently claimed processing is recognized by Biggs to be insufficient. This is a secondary factor of non-obviousness, *i.e.*, criticism of the claimed

invention and/or disbelief that the invention would work as claimed, in that Biggs (one of ordinary skill in the art) did not believe that a process as presently claimed could work and that was the reason for Biggs' invention (Biggs, Col. 1, lines 9-28). Further, present claim 21 specifically recites that the different filling is *disposed* into the wafer, which is further distinct from the "introducing" into or upon feature of claim 10 and also not taught by Biggs.

Moreover, the *molten filling* of the present claims is not pre-formed and would not be conducive to shaping a deformable wafer around it, as taught by Biggs. Instead, claims 10-11 recite that the molten confectionery mass is filled upon or into the previously shaped wafer, and the filling is allowed to solidify prior to consumption. Biggs cannot render obvious the process claims since it teaches directly away from the recited process steps. Moreover, Biggs does not even suggest the use of a substantially water-free fat-based confection of claim 10 as a filling or the combination of such a filling with a cone shaped wafer in claim 11. Indeed, Biggs teaches away from such process by suggesting that the presence of water is preferred in many of its specifically enumerated fillings, including at least ice cream, vegetables, and fruit, all of which have a well known water content. At best, Biggs fails to teach substantially avoiding the water in the filling. Claim 23 recites that the food mass flows to conform to the shape of the wafer, and then the mass is sufficiently solidified to harden in a shape corresponding to the wafer. Biggs teaches a pre-formed food core, but fails to teach that the food can flow, that the food can take the shape of a wafer rather than vice versa, that the food is a substantially water-free mass rather than pieces, and that the food can harden after the wafer has surrounded it. Claim 23 is thus also respectfully submitted to be patentable over Biggs. Applicant cannot express strongly enough how Biggs teaches away from the claimed process.

Other dependent claims recite further differences over Biggs. Claims 3 and 13 recite that the product has a weight of about 5 and 40 g and is bite-sized or a 2-3 bite sized piece. There is no showing in Biggs as to product weight or any importance thereof. Also, claims 17 and 19 recite that the food product may include a topping, which cannot be shown by Biggs since it teaches a wafer open only at the sides, *i.e.*, a taco-like product (Biggs, Col. 2, line 30). Claim 17 also recites that the top of the filling is shaped into a dome to provide the appearance of ice cream, which dome shape process is not taught by Biggs. Biggs forms its' wafer around the food core, thus, it cannot possibly even suggest a process where filling is provided outside the pre-formed wafer, much less a specific shape of filling outside the wafer, as presently recited in claim 17. As Biggs does not disclose these features, these claims are further distinguished from the teachings of Biggs. For these reasons, the rejection

of claims 1 and 3-21 under 35 U.S.C. § 103(a) should be reconsidered and withdrawn, since no *prima facie* case of obviousness has been stated on the record.

Accordingly, the entire application is now in condition for allowance, early notice of which would be appreciated. Should the Examiner not agree with the Applicants' position, then a personal or telephonic interview is respectfully requested to discuss any remaining issues and expedite the eventual allowance of the application.

An Amendment Fee Transmittal is submitted herewith for the two additional total claims added in this submission. Should any additional fees be due, however, please charge such fees to Winston & Strawn Deposit Account No. 501-814.

Respectfully submitted,

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APPENDIX A: MARKED-UP AMENDED CLAIMS

1. (Amended) A food product comprising a sugar wafer cone having a filling including a mass of a substantially water-free based confectionery material that has solidified in the sugar wafer from a molten, semi-liquid, or semi-solid mass [state] prior to consumption, so that the cone acts as a handle to keep a user's hands clean during eating of the product and the product combines the pleasure and fun of eating an ice cream cone with the indulgence of a fat-based confection.

10. (Twice Amended) A process for preparing a food product comprising a sugar wafer having a substantially water-free fat based confectionery filling which comprises providing the sugar wafer in a desired shape, introducing a substantially water-free fat-based confectionery in a molten, semi-liquid or semi-solid mass upon or into the shaped sugar wafer, and allowing the confectionery mass to harden to form the food product.

21. (Amended) The process [food product] of claim 10, wherein the introducing comprises disposing [filling the shaped sugar wafer with] molten, semi-liquid, or semi-solid mass into the shaped sugar wafer.